

REMARKS

Claims 29 to 55 are pending in the application, of which claims 28 to 47 are currently under consideration. Claims 29 to 36, 40, and 44 have been amended. The amendments to claims 29 to 36, 40, and 44 merely serve to even more clearly recite the claimed invention.

Restriction Requirement

Applicants note with appreciation that the Examiner has extended the examination of Group 1 “beyond the elected species of SEQ ID NO: 19 (SEQ ID NO: 18) to include all of the species.” Action at item 1, page 2.

Specification

The Examiner stated that “...the first line of the specification does not indicate that application 09/927,180 is now U.S. Patent No. 6,645,736, or reference PCT/US95/08069.” Action at item 2, page 2. The Examiner further stated that “[a]pplicant should amend the first line of the specification to claim priority to PCT/US95/08069 and indicate that application 09/927,180 is now U.S. Patent No. 6,645,736.” *Id* at page 3. Applicants have amended the first line of the specification as suggested by the Examiner.

The Examiner alleged that the abstract of the application makes no reference to antibodies and suggested amending the abstract to recite antibodies. Action at item 2, page 3. Applicants have amended the specification by replacing the Abstract at page 66 with the enclosed replacement Abstract, which refers to antibodies.

Rejection under 35 U.S.C. § 101

The Examiner rejected claims 29 to 47 under 35 U.S.C. § 101, alleging that “the claimed invention is directed to non-statutory subject matter.” Action at item 3, page 4. Specifically, the Examiner alleged that the claimed antibodies are products of nature and suggested amending the claims to recite “an isolated and purified antibody.” *Id.*

Solely to expedite prosecution and without acquiescing to the rejection, applicants have amended claims 29, 40, and 44 to recite “[a] purified antibody.” Claims 30 to 39 depend from claim 29. Claims 41 to 43 depend from claim 44. Claims 45 to 47 depend from claim 44. Those amendments should obviate the Examiner’s rejection.

Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 101.

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 44 to 47 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Action at item 5, page 4. The Examiner alleged that “[b]ase claim 44 recites an antibody that binds to a polypeptide encoded by nucleic acid sequences, two of which are the DNA insert of the plasmid deposited with ATCC as accession number 69948 and the DNA insert of the plasmid deposited with ATCC as accession number 69949.” *Id.* The Examiner requested that applicant submit an affidavit or declaration stating that accession nos. 69948 and 69949 have been deposited under the Budapest Treaty and that those deposits will be released to the public upon the issuance of a patent. *Id.* at page 5.

Applicants submit a copy of the American Type Culture Collection (ATCC) deposit receipt for accession nos. 69948 and 69949. The deposit receipt is entitled “Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure” and states that those deposits were received by the ATCC on November 7, 1995. The deposit receipt further stated that “[t]he strains will be made available if a patent office signatory to the Budapest Treaty certifies one’s right to receive, or if a U.S. Patent is issued citing the strains and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strain.” Submission of the deposit receipt should obviate the rejection of claims 44 to 47 under 35 U.S.C. § 112, first paragraph.

Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 29 to 47 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Action at item 7, page 6. The Examiner alleged that “[c]laims 29-31, 33, 35, and 37-39 recite ‘a polypeptide having’ or ‘the polypeptide has’ a certain amino acid sequence.” *Id.* at item 7(A), page 6. The Examiner further requested that applicant amend those claims to recite either “consisting of” or “comprising” in place of “having” and “has.” *Id.*

Solely to expedite prosecution and without acquiescing to the rejection, applicants have amended claim 29 to recite “[a] purified antibody that specifically binds to an epitope in an amino acid sequence selected from” Solely to expedite prosecution and without acquiescing to the rejection, applicants have amended claims 30, 31, 33, and 35 to recite

“wherein the epitope is in the amino acid sequence of” Solely to expedite prosecution and without acquiescing to the rejection, applicants have amended claims 32, 34, and 36 to recite “wherein the epitope is in a fragment of the amino acid sequence of” Finally, claims 37 to 39 depend from claim 29 and do not additionally recite “having” or has.” Thus, the amendment to claim 29 should obviate the rejection with respect to claims 37 to 39.

The Examiner also alleged that claims 29 to 47 are indefinite because they “recite an antibody that binds a sequence.” Action at item 7(B), page 6. The Examiner further alleged that “[a]ll antibodies are capable of both specific and non-specific binding of antigens due to cross-reactivity.” *Id.* The Examiner suggested amending the claims to recite “specifically binds” in place of “binds.”

Solely to expedite prosecution and without acquiescing to the rejection, applicants have amended claims 29, 40, and 44 to recite “specifically binds” as suggested by the Examiner. Claims 30 to 39 depend from claim 29. Claims 41 to 43 depend from claim 44. Claims 45 to 47 depend from claim 44.

Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.


Applicants respectfully assert that the present application is in condition for allowance and request that the Examiner issue a timely Notice of Allowance. If the Examiner does not consider the application to be allowable, the undersigned requests that, prior to taking action, the Examiner call her at (650) 849-6656 to set up an interview.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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By: 
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